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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,134	06/14/2001	Norman Yamamoto	310048-581	8098

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EXAMINER

NGUYEN, KIMBERLY T

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

mk-5

Office Action Summary

Application No.

09/881,134

Applicant(s)

YAMAMOTO ET AL.

Examiner

Kimberly T. Nguyen

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 12, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 28, it is not clear whether the “cover” or the “surface” is “formed from a water-resistant material.” For purposes of examination, these claims will be understood to show that the *surface* comprises a water-resistant material.

Claim 12 recites the limitation “the gel ink-receptive coating” in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim.

In claim 28, it is unclear which “water-resistant sheet material” has the ink-receptive coating disposed on it. Applicant shows 2 different “water-resistant sheet materials.”

Claims 24-26 are rejected under 35 U.S.C. 112, 2nd paragraph, as being incomplete for omitting essential structural components of elements, such omission amounting to a gap between the necessary structural connections. See MPEP 2173.05(k) and 2172.01. The omitted structural cooperative relationships are: it is unclear how the “primer layer,” “cover,” and “ink-receptive coating” are interrelated and where they are located in the photo album. Claim 24 shows that the primer is disposed on the “surface of the cover” while claim 1 shows that the “ink-receptive coating” is disposed on at least a portion of a surface” of the cover.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-8, 10-13, 16-18, and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson et al., U.S. Pat. No. 6,316,081 B1 in view of Shih et al., U.S. Pat. No. 6,153,288 in further view of Bazaj et al., U.S. Pat. No. 6,281,291 B1.

Nelson shows a photographic album comprising jackets 10 (sheets), face sheets 28 (cover), and a transparent ink receptive cover 20 wherein the jackets and face sheets are connected to form the album (Figures 10-12).

Nelson does not specifically show the ink receptive coating as in instant claim 1. Shih shows an ink-receptive composition which can be used on coated products comprising colloidal silica pigment (column 5, lines 41-50), polyvinyl alcohol (claim 8), a copolymer comprising polydiallyldimethylammonium chloride, quaternary amino acrylate or methacrylate (cationic monomer), a hydroxy-lower alkyl acrylate or methacrylate (neutral monomer), methacrylic or acrylic acid (column 3, lines 6-15), hydroxyethylmethacrylate (column 1, line 51), polyethylene glycol (column 4, lines 46-56), and a formaldehyde crosslinker (column 6, lines 26-34).

Nelson does not specifically show that the face sheet (cover) comprises a water-resistant material as in instant claim 1. Shih shows that coatable substrates include paper, plastic, or metal face stocks (column 6, lines 35-56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make a photo album with a water-resistant cover in order to protect the sheets and photographs.

Art Unit: 1774

Shih does not show that the polyvinyl alcohol has a saponification level of about 85 to 95% as in instant claim 10. Shih does not show that the pigment comprises nano-sized particles as in instant claim 17. Shih does not specifically show the percentages by weight of the monomers, polymers, copolymers, and surfactants as in instant claims 4-5, 9, and 20. Shih does not specifically show that the polyethylene glycol has a weight-average molecular weight as in instant claim 11. Shih does not specifically show the coat weight of the ink-receptive coating as in instant claim 22. However, such a saponification level, size of particles, percentages by weight, weight-average molecular weight, and coat weight are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the saponification level, particle size, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are result-effective as they control the level of saponification, pigment level, and ink-receptivity of the coating. As such, they are optimizable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the ink-receptive coating with the limitations of the saponification level, particle size, percentages by weight, weight-average molecular weight, and coat weight since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Art Unit: 1774

Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson et al., U.S. Pat. No. 6,316,081 B1 in view of Shih et al., U.S. Pat. No. 6,153,288 in further view of Bazaj et al., U.S. Pat. No. 6,281,291 B1.

Nelson and Shih are relied upon as above for claim 1.

Nelson and Shih do not show the nonionic polymer as in instant claim 3. Bazaj shows a paper treating composition to enhance ink-receptivity comprising carboxymethylcellulose (column 8, lines 15-38). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the ink-receptive coating with carboxymethylcellulose because carboxymethylcellulose is a known stabilizing agent in ink-receptive compositions (column 8, lines 15-38).

Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson et al., U.S. Pat. No. 6,316,081 B1 in view of Shih et al., U.S. Pat. No. 6,153,288 in further view of Bazaj et al., U.S. Pat. No. 6,281,291 B1.

Nelson and Shih are relied upon as above for claim 1.

Nelson and Shih do not specifically show that 2-acrylamido-2-methylpropane sulfonic acid can be used in the ink-receptive coating as in instant claim 9. Bazaj shows a paper treating composition to enhance ink-receptivity comprising carboxymethylcellulose (column 8, lines 15-38), methacrylic acid, and 2-acrylamido-2-methylpropane sulfonic acid (column 6, lines 18-38). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the ink-receptive coating with 2-acrylamido-2-methylpropane sulfonic acid because it is a known cationic monomer for use in ink-receptive coatings. Further, 2-acrylamido-2-methylpropane sulfonic acid and methacrylic acid are functional equivalents.

Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson et al., U.S. Pat. No. 6,316,081 B1 in view of Shih et al., U.S. Pat. No. 6,153,288 in further view of Bazaj et al., U.S. Pat. No. 6,281,291 B1.

Nelson and Shih are relied upon as above for claim 1. Shih does not specifically show that the crosslinkers comprise glyoxal and polyethoxylated dialdehyde as in instant claim 14-15. Erdtmann shows that SQUAREZ 755 (polyethoxylated dialdehyde) and glyoxal are known crosslinkers in ink-receptive layers (column 14, lines 53-66). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the ink-receptive coating with the crosslinkers of SQUAREZ 755 and glyoxal since it is known that these are effective hardeners and enhance waterfastness of printed images.

Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson et al., U.S. Pat. No. 6,316,081 B1 in view of Shih et al., U.S. Pat. No. 6,153,288 in further view of Bazaj et al., U.S. Pat. No. 6,281,291 B1.

Nelson and Shih are relied upon as above for claim 1. Nelson does not show that a primer is disposed on face sheets as in instant claim 24. Shih shows that the label stock can be primed with polyvinyl acetate (column 9, lines 34-44). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the face sheets (cover) with a primer layer to enhance adhesion of the ink-receptive coating.

Shih does not show the thickness of the primer as in instant claim 26. However, such a range of thicknesses is a property which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the thickness, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine

Art Unit: 1774

experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. thickness) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are optimizable as they control the level of adhesion of the ink-receptive layer to the face sheets (cover). As such, they are optimizable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the photo album with the limitation of the primer thickness since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Udwin et al., U.S. Pat. No. 6,106,015 in view of Shih et al., U.S. Pat. No. 6,153,288.

Udwin shows a binder which can hold photographs having a front and back cover which comprise two vinyl layers 34,36 or 42,44 with a cardboard stiffener in-between the vinyl or polypropylene layers (water-resistant) (column 5, line 58 to column 6, line 41) and pages 52 (sheets) for receiving the photographs (Figure 2A). Udwin shows that the covers have a turned-edge (Figures 1D-2B).

Though Udwin shows on page 1, lines 50-58 that the covers can be imprinted and decorated, Udwin does not specifically show an ink receptive coating on the exterior of the front and/or back cover as in instant claims 28 and 30. Shih shows an ink-receptive composition which can be used on coated products comprising colloidal silica pigment (column 5, lines 41-50), polyvinyl alcohol (claim 8), a copolymer comprising polydiallyldimethylammonium chloride, quaternary amino acrylate or methacrylate (cationic monomer), a hydroxy-lower alkyl acrylate or methacrylate (neutral monomer), methacrylic or acrylic acid (column 3, lines 6-15),

Art Unit: 1774

hydroxyethylmethacrylate (column 1, line 51), polyethylene glycol (column 4, lines 46-56), and a formaldehyde crosslinker (column 6, lines 26-34). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the binder of Udwin with the ink-receptive coating of Shih on the covers since it is known that the ink-receptiveness of the covers can be enhanced with ink-receiving coatings. Shih also shows that its coating is used for enhancing the ink-receptiveness of imprintable substrates (column 1, lines 6-9).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday, except on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

CYNTHIA H. KELLY
SUPERVISOR
APR 17 2010

Cynthia H. Kelly